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EXAMINER

LE, MICHAEL

ART UNIT

PAPER NUMBER

2163

NOTIFICATION DATE

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ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/606,362

Applicant(s)

KIM, YOUNG-CHUL

Examiner

MICHAEL LE

Art Unit

2163

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 16, 17, 21-24, 26, 28, 29, 31, 32, 34, 35 and 40-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 16, 17, 21-24, 26, 28, 29, 31, 32, 34, 35 and 40-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/29/2008.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Summary and Status of Claims***

1. This Office Action is in response to Applicant's reply filed October 29, 2008.
2. Claims 1-11, 16, 17, 19, 21-24, 26, 28, 29, 31, 32, 34, 35, and 40-43 are pending.
3. Claims 1-6, 9, 10, 16, 17, 21-24, 26, 28, 29, 31, 32, 34, 35, and 40-43 are rejected under 35 U.S.C. 112, first paragraph.
4. Claims 32 and 35 are rejected under 35 U.S.C. 112, second paragraph.
5. Claims 1, 2, 4, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Hirayama et al. (US Patent 5,652,824) of record.
6. Claims 3, 5-8, 10, 11, 16, 17, 19, 21-24, 26, 28, 29, 31, 32, 34, 35, and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirayama et al. (US Patent 5,652,824) of record, in view of Ohno (US Patent 5,541,663) of record.
7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Information Disclosure Statement***

8. Applicant's submission of the English abstract for the foreign BA reference is acknowledged. Consequently, the reference has been considered.

***Claim Objections***

9. Claim 17 is objected to because of the following informalities:
  10. In claim 17, line 2 “download” has to be changed to --downloaded--.
- Appropriate correction is required.

***New Matter – 35 U.S.C. 251***

11. **Claims 1-6, 9, 10, 16, 17, 19, 21-24, 26, 28, 29, 31, 32, 34, 35, and 40-43 are rejected under 35 U.S.C. 251** as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

Applicant’s amendment to the specification and the abstract contain features that are considered new matter. In particular, the abstract discusses (1) an optical disc player, which was previously a DVD player, and the feature of (2) downloading from the optical disc and storing in a memory a first font data such that it is separate from the characters of the selected language before the character generation unit generates the characters of the selected language, which previously did not exist. The amendment to the specification discusses features (1) and (2) as noted above, and the features of (3) the first font data being different than a second font data and (4) the first and second font data are different than text data.

As a result of the amendments to the Specification and abstract containing new matter, the amendments will not be entered.

***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. **Claims 1-6, 9, 10, 16, 17, 21-24, 26, 28, 29, 31, 32, 34, 35, and 40-43 are rejected under 35 U.S.C. 112, first paragraph**, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

14. Applicant's amendment to the specification and the abstract contain features that are considered new matter. In particular, the abstract discusses (1) an optical disc player, which was previously a DVD player, and the feature of (2) downloading from the optical disc and storing in a memory a first font data such that it is separate from the characters of the selected language before the character generation unit generates the characters of the selected language, which previously did not exist. The amendment to the specification discusses features (1) and (2) as noted above, and the features of (3) the first font data being different than a second font data and (4) the first and second font data are different than text data.

15. These features were not described or discussed in the original specification and are therefore considered new matter. The rejected claims contain one or more of the aforementioned features and are therefore rejected under 35 U.S.C. 112, first paragraph.

16. In addition, claims 17 and 24 recite the feature of "said additional contents is downloaded from an external source." This feature broadens the scope of the original claims and of the

original disclosure. There is no indication as to what the "external source" is. Therefore, it could potentially be interpreted as anything not apart of the apparatus.

17. Claims 40 and 42, which depend on claims 17 and 24 respectively, further limit the "external source" recited in claims 17 and 24 to an "optical disc." As discussed above, the limitation of an "optical disc" broadens the scope of the original disclosure and claims because the original disclosure and claims were limited to DVDs. Optical discs encompass more than just DVDs, including CDs, Laser-Discs, CD-RWs, etc.

18. For these additional reasons, claims 17, 24, 40, and 42 are rejected under 35 U.S.C. 112, first paragraph.

19. The prior art rejections to claims 1-6, 9, 10, 16, 17, 21-24, 26, 28, 29, 31, 32, 34, 35, and 40-43 below are made as best understood in light of the rejection under 35 U.S.C. 112, first paragraph addressed above.

20. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

21. **Claims 32 and 35 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

22. Claims 32 and 35 recite "the video management information" in line 2 respectively. There is a lack of antecedent basis for this limitation in the claims. For the prior art rejections below, claims 32 and 35 will be treated as depending on claims 31 and 34 respectively, which would resolve the antecedent basis issue.

23. The prior art rejections of claims 32 and 35 below are made as best understood in light of the rejection under 35 U.S.C. 112, second paragraph addressed above.

*Claim Rejections - 35 USC § 102*

24. **Claims 1, 2, 4, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Hirayama et al. (US Patent 5,652,824) (Hirayama).**

25. In regards to **claim 1**, Hirayama discloses a character display apparatus for an optical disc player, the apparatus comprising:

- a. a detection and separation unit to detect recorded data including a first font data from said optical disc, and to separate said first font data from the detected recorded data (Hirayama at Fig. 1, element 203);
- b. a memory to store the first font data output from said detection and separation unit (Hirayama at Fig. 9, element 405);
- c. a character generation unit to generate character signals for characters of a selected language of a subtitle by using the first font data stored in said memory (Hirayama at Fig. 1, element 203); and
- d. a controller coupled to the character generation unit, to cause the character generation unit to generate the character signals for the characters of the selected language for character subtitle processing selected from multiple languages to be used in the character subtitle processing on the basis of the first font data (Hirayama at Fig. 1, element 204; col. 5, lines 36-7; col. 6, lines 5-8; col. 9, lines 19-29),

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e. wherein the first font data is downloaded from the optical disc and stored in the memory such that the stored first font data is separate from the characters of the selected language before the character generation unit generates the characters of the selected language. Hirayama at col. 5, lines 30-9; col. 6, lines 5-9.

26. In regards to **claim 2**, Hirayama discloses the character display apparatus according to claim 1, wherein said detection and separation unit comprises:

a. a pickup to detect the recorded data including said first font data from said optical disc, and to output the detected recorded data as output signals (Hirayama at col. 5, lines 20-5);

b. a high frequency processing unit to process the output signals of said pickup, and to output video data signals (Hirayama at col. 5, lines 25-6); and

c. a data separation unit to separate said first font data from the output video data signals of said high frequency unit, and to output the separated first font data (Hirayama at col. 5, lines 28-32),

d. wherein said controller controls said high frequency processing unit, said data separation unit, said memory and said character generation unit. Hirayama at col. 5, lines 36-7.

27. In regards to **claim 4**, Hirayama discloses a character display method for an optical disc player, comprising:

a. detecting recorded data including first font data recorded in an optical disc, and outputting said detected recorded data as output signals (Hirayama at col. 5, lines 23-32)



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- b. processing the output signals, and outputting video signals (Hirayama at col. 5, lines 30-2);
  - c. separating said first font data from the video signals, and outputting the separated first font data (Hirayama at col. 5, lines 30-2);
  - d. storing the first font data in a first memory (Hirayama at col. 11, lines 13-6); and
  - e. outputting character signals of characters for a selected language for character subtitle processing by using the first font data stored in said first memory (Hirayama at col. 12, lines 26-48),
  - f. wherein the first font data is downloaded from the optical disc and stored in the first memory such that the stored first font data is separate from the characters of the selected language before the outputting step outputs the characters of the selected language. Hirayama at col. 5, lines 30-9; col. 6, lines 5-9.
28. In regards to **claim 9**, Hirayama discloses a character display method for an optical disc player, comprising:
- a. selecting a language for character subtitle processing from multiple languages (Hirayama at col. 11, lines 33-6);
  - b. separating first font data from other data read from a disc (Hirayama at col. 5, lines 24-33);
  - c. storing the separated first font data in a first memory (Hirayama at col. 11, lines 13-6); and
  - d. generating character signals from the stored first font data or from predetermined second font data stored in a second memory (Hirayama at col. 12, lines 26-48), thereby

outputting character signals for characters of the selected language to be used in the character subtitle processing on the basis of said first or second font data (Hirayama at col. 12, lines 26-48),

e. wherein the first font data is downloaded from the disc and stored in the first memory such that the stored first font data is separate from the characters of the selected language before the generating step outputs the characters of the selected language.

Hirayama at col. 5, lines 30-9; col. 6, lines 5-9.

***Claim Rejections - 35 USC § 103***

29. **Claims 3, 5-8, 10, 11, 21, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirayama in view of Ohno (US Patent 5,541,663).**

30. In regards to **claim 3**, Hirayama does not expressly disclose a second memory for storing second font data of predetermined languages, said second font data being different than said first font data, and using the second font data in the second memory if the first font data of the selected language are not on said optical disc.

31. Ohno discloses a font ROM storing character patterns that are used to generate characters for display on the screen with video images stored on a laser disc (i.e., optical disc). Ohno at Fig. 4, element 2; col. 3, lines 54-60; col. 4, lines 1-17.

32. Hirayama and Ohno are analogous art because they are both directed toward the field of font and character display from an optical medium.

33. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the apparatus of Hirayama by adding the second memory storing second font data of

predetermined languages and using the second font data in the second memory if the first font data of the selected language is not on the optical disc, using the font ROM as taught by Ohno. The font ROM would add an additional font storage (i.e., second memory) that would be used if the font needed was not stored on the optical disc. This saves space on the disc. It would be different from the font stored on the disc (i.e., first font data) because it would be counter productive to store duplicate fonts.

34. The motivation for doing so would have been because it saves space on the medium as the font data is stored independent of the medium.

35. **Claim 5** is essentially the same as claim 3 in the form of a method and is therefore rejected for the same reasons.

36. In regards to **claim 6**, Hirayama discloses a character display method for an optical disc player, the method comprising:

- a. determining whether first font data corresponding to at least some of multiple languages to be used in character subtitle processing are recorded in an optical disc (Hirayama at col. 5, lines 24-33);
- b. storing the first font data in a first memory, if the first font data corresponding to characters of languages for the character subtitle processing are stored in said optical disc (Hirayama at col. 11, lines 13-6);

- c. outputting character signals for characters of a selected language for the character subtitle processing according to the first font data stored in said first memory when one of said multiple languages is selected (Hirayama at col. 12, lines 26-48);
- d. wherein the first font data is downloaded from the optical disc and stored in the first memory such that the stored first font data is separate from the characters of the selected language before the outputting step outputs the characters of the selected language. Hirayama at col. 5, lines 30-9; col. 6, lines 5-9.

37. Hirayama does not expressly disclose outputting the character signals for the characters of the selected language using second font data of the selected language from a second memory if the first font data of the selected language are not recorded in said disc.

38. Ohno discloses a font ROM storing character patterns that are used to generate characters for display on the screen with video images stored on a laser disc (i.e., optical disc). Ohno at Fig. 4, element 2; col. 3, lines 54-60; col. 4, lines 1-17.

39. Hirayama and Ohno are analogous art because they are both directed toward the field of font and character display from an optical medium.

40. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the apparatus of Hirayama by adding the step of outputting the character signals by using the second font data of the selected language from a second memory if the first font data of the selected language are not recorded in said disc, using the font ROM as taught by Ohno. The font ROM would add an additional font storage (i.e., second memory) that would be used if the font needed was not stored on the optical disc. This saves space on the disc. It would be

different from the font stored on the disc (i.e., first font data) because it would be counter productive to store duplicate fonts.

41. The motivation for doing so would have been because it saves space on the medium as the font data is stored independent of the medium.

42. In regards to **claim 7**, Hirayama discloses a character display apparatus for an optical disc player, the apparatus comprising:

- a. a data separator to separate first font data to be used in character subtitle processing from a predetermined area of an optical disc (Hirayama at col. 5, lines 24-32);
- b. a first memory to store the separated first font data (Hirayama at Fig. 9, element 405);
- c. a character generator to generate character signals for characters of a selected language for the character subtitle processing from stored first font data stored in the first memory (Hirayama at Fig. 1, element 203); and
- d. a controller to cause the character generator to generate the character signals for the characters of the selected language for the character subtitle processing from the first font data stored in the first memory (Hirayama at Fig. 1, element 204; col. 11, lines 12-3), thereby outputting the character signals for the characters of a selected language for the character subtitle processing selected from multiple languages to be used in the character subtitle processing on the basis of said first font data. Hirayama at col. 5, lines 36-7; col. 6, lines 5-8; col. 9, lines 19-29.

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43. Hirayama does not expressly disclose a second memory to store predetermined second font data to be used in character subtitle processing.

44. Ohno discloses a font ROM storing character patterns that are used to generate characters for display on the screen with video images stored on a laser disc (i.e., optical disc). Ohno at Fig. 4, element 2; col. 3, lines 54-60; col. 4, lines 1-17.

45. Hirayama and Ohno are analogous art because they are both directed toward the field of font and character display from an optical medium.

46. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the apparatus of Hirayama by adding the second memory storing predetermined second font data to be used in multilingual subtitle processing, as taught by Ohno.

47. The motivation for doing so would have been because it saves space on the medium as the font data is stored independent of the medium.

48. In regards to **claim 8**, Hirayama in view of Ohno discloses the character display apparatus according to claim 7, wherein the second memory is a read only memory. Ohno at col. 3, lines 54-60.

49. Hirayama and Ohno do not expressly disclose wherein the first memory is a random access memory.

50. Random access memory is well known in the computer and electrical arts. It is a simple type of memory that is volatile. It is used for storing data that will be used temporarily and does not require long storage times because it allows for faster access to the stored data than a conventional platter based hard drive.

51. At the time of the invention, it would have been obvious to one of ordinary skill in the art to make the first memory in Hirayama in view of Ohno a random access memory.

52. The motivation for doing so would have been because the information taken from the optical disc does not need to be stored for a long period of time, but only temporary. In addition, the data is only needed while the optical disc is being played and is stored on the first memory to be quickly accessed without having to refer back to the optical disc, which could slow the reading of other data on the disc.

53. In regards to **claim 10**, Hirayama does not expressly disclose, wherein said generating step further includes generating the character signals for the characters of the selected language from the predetermined second font data if the selected language does not correspond to the stored first font data in the first memory.

54. Ohno discloses a font ROM storing character patterns that are used to generate characters for display on the screen with video images stored on a laser disc (i.e., optical disc). Ohno at Fig. 4, element 2; col. 3, lines 54-60; col. 4, lines 1-17.

55. Hirayama and Ohno are analogous art because they are both directed toward the field of font and character display from an optical medium.

56. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the apparatus of Hirayama by adding the second memory storing predetermined second font data to be used when the selected language does not correspond to the stored first font data in the first memory, using the font ROM as taught by Ohno. The font ROM would add an additional font storage (i.e., second memory) that would be used if the font needed was not

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stored on the optical disc. This saves space on the disc. It would be different from the font stored on the disc (i.e., first font data) because it would be counter productive to store duplicate fonts.

57. The motivation for doing so would have been because it saves space on the medium as the font data is stored independent of the medium.

58. In regards to **claim 11**, Hirayama discloses a system for generating character signals for a selected language of a subtitle recorded in an optical disc, said optical disc including at least a predetermined area on which first font data for generating character signals to be used in multilingual subtitle processing are located (Hirayama at col. 2, lines 37-41), the system comprising:

- a. an optical pickup to read recorded data including the first font data to be used in the character subtitle processing (Hirayama at col. 5, lines 20-4);
- b. a data processor to process the first font data read from the optical pickup (Hirayama at col. 5, lines 24-32);
- c. a first memory to store the first font data (Hirayama at Fig. 9, element 405);
- d. a character generator to generate the character signals for characters of the selected language for the character subtitle processing from the first font data stored in the first memory (Hirayama at Fig. 1, element 203); and
- e. a controller to cause the character generator to generate the character signals for the characters of the selected language from the first font data stored in the first memory, based on the selected language (Hirayama at Fig. 1, element 204; col. 11, lines 12-3),



thereby outputting the character signals for the characters of the selected language from multiple languages to be used in the character subtitle processing on the basis of the first font data (Hirayama at col. 5, lines 36-7; col. 6, lines 5-8; col. 9, lines 19-29),

f. wherein the first font data is downloaded from the optical disc and stored in the first memory such that the stored first font data is separate from the characters of the selected language before the controller outputs the characters of the selected language.

Hirayama at col. 5, lines 30-9; col. 6, lines 5-9.

59. Hirayama does not expressly disclose a second memory to store predetermined second font data to be used in character subtitle processing.

60. Ohno discloses a font ROM storing character patterns that are used to generate characters for display on the screen with video images stored on a laser disc (i.e., optical disc). Ohno at Fig. 4, element 2; col. 3, lines 54-60; col. 4, lines 1-17.

61. Hirayama and Ohno are analogous art because they are both directed toward the field of font and character display from an optical medium.

62. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the apparatus of Hirayama by adding the second memory storing predetermined second font data to be used in character subtitle processing, as taught by Ohno.

63. The motivation for doing so would have been because it saves space on the medium as the font data is stored independent of the medium.

64. In regards to **claim 16**, Hirayama discloses an apparatus for an additional contents display of an optical disc player, the apparatus comprising:

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- a. a detector to detect additional contents data associated with a main title of an optical disc, wherein the additional contents data include a first font data (Hirayama at col. 5, lines 24-33);
  - b. a first memory to store said additional contents data (Hirayama at col. 11, lines 13-6);
  - c. a processor to process said additional contents data stored in said first memory to generate specific presentation data (Hirayama at fig. 9, element 401; col. 12, lines 33-9); and
  - d. a controller to control the processor to process said additional contents data to display a specific content associated with said main title by using said specific presentation data (Hirayama at Fig. 1, element 204; col. 11, lines 12-3),
  - e. wherein the processor processes the additional contents data including the first font data stored in the first memory of the optical disc player (Hirayama at col. 5, lines 30-9; col. 6, lines 5-9), and
  - f. wherein the first font data is different than text data. Hirayama at col. 5, lines 30-9; col. 6, lines 5-9.
65. Hirayama does not expressly disclose the first font data being different than a second font data predetermined for the main title and the second font data being different than text data.
66. Ohno discloses a font ROM storing character patterns that are used to generate characters for display on the screen with video images stored on a laser disc (i.e., optical disc). Ohno at Fig. 4, element 2; col. 3, lines 54-60; col. 4, lines 1-17.

67. Hirayama and Ohno are analogous art because they are both directed toward the field of font and character display from an optical medium.

68. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the apparatus of Hirayama by adding the second memory storing predetermined second font data to be used in character subtitle processing, using the font ROM as taught by Ohno. The font ROM would add an additional font storage (i.e., second memory) that would be used if the font needed was not stored on the optical disc. This saves space on the disc.

69. The motivation for doing so would have been because it saves space on the medium as the font data is stored independent of the medium.

70. In regards to **claim 17**, Hirayama in view of Ohno discloses the apparatus according to claim 16, wherein said additional contents is downloaded from an external source. Hirayama at col. 5, lines 30-9.

71. In regards to **claims 19 and 26**, Hirayama in view of Ohno does not expressly disclose, wherein said first memory is a random access memory.

72. Random access memory is well known in the computer and electrical arts. It is a simple type of memory that is volatile. It is used for storing data that will be used temporarily and does not require long storage times because it allows for faster access to the stored data than a conventional platter based hard drive.

73. At the time of the invention, it would have been obvious to one of ordinary skill in the art to make the first memory in Hirayama a random access memory.

74. The motivation for doing so would have been because the information taken from the optical disc does not need to be stored for a long period of time, but only temporary. In addition, the data is only needed while the optical disc is being played and is stored on the first memory to be quickly accessed without having to refer back to the optical disc, which could slow the reading of other data on the disc.

75. In regards to **claim 21**, Hirayama in view of Ohno discloses the apparatus according to claim 16, wherein said second font data is stored in a second memory, the second memory being a read only memory. Ohno at Fig. 4, element 2; col. 3, lines 54-9.

76. In regards to **claim 22**, Hirayama in view of Ohno discloses the apparatus according to claim 16, wherein said processor is a character generator to generate character signals for characters for displaying a selected language on the basis of said first or second font data. Hirayama at col. 12, lines 25-48.

77. In regards to **claim 23**, Hirayama discloses a method for an additional contents display of an optical disc player, the method comprising:

- a. detecting additional contents data associated with a main title of an optical disc, wherein the additional contents data include first font data (Hirayama at col. 5, lines 24-33);
- b. storing said additional contents data in a first memory (Hirayama at col. 11, lines 13-6);

- c. processing said stored additional contents data to generate specific presentation data (Hirayama at col. 12, lines 26-48); and
- d. outputting the specific presentation data for display a specific content associated with said main title by using said specific presentation data (Hirayama at col. 12, lines 26-48),
- e. wherein the processing step processes the additional contents data including the first font data stored in the first memory of the optical disc player (Hirayama at col. 5, lines 30-9; col. 6, lines 5-9), and
- f. wherein the first font data is different than text data. Hirayama at col. 5, lines 30-9; col. 6, lines 5-9.

78. Hirayama does not expressly disclose the first font data being different than a second font data predetermined for the main title and the second font data being different than text data.

79. Ohno discloses a font ROM storing character patterns that are used to generate characters for display on the screen with video images stored on a laser disc (i.e., optical disc). Ohno at Fig. 4, element 2; col. 3, lines 54-60; col. 4, lines 1-17.

80. Hirayama and Ohno are analogous art because they are both directed toward the field of font and character display from an optical medium.

81. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the apparatus of Hirayama by adding the second memory storing predetermined second font data to be used in character subtitle processing, using the font ROM as taught by Ohno. The font ROM would add an additional font storage (i.e., second memory) that would be used if the font needed was not stored on the optical disc. This saves space on the disc.

82. The motivation for doing so would have been because it saves space on the medium as the font data is stored independent of the medium.

83. In regards to **claim 24**, Hirayama in view of Ohno discloses the method according to claim 23, wherein said additional contents is downloaded from an external source. Hirayama at col. 5, lines 30-9.

84. In regards to **claim 28**, Hirayama in view of Ohno discloses the method according to claim 23, wherein said second font is stored in a second memory, said second memory being a read only memory. Ohno at Fig. 4, element 2; col. 3, lines 54-9.

85. In regards to **claim 29**, Hirayama in view of Ohno discloses the method according to claim 23, where said processing is performed to generate character signals for characters for displaying a selected language on the basis of first or second font data. Hirayama at col. 11, lines 33-46.

86. In regards to **claim 31**, Hirayama in view of Ohno discloses the method according to claim 24, further comprising reproducing video management information from the optical disc (Hirayama at col. 11, lines 13-6), wherein the video management information includes information indicating whether or not the first font data are recorded on the optical disc. Hirayama at col. 8, lines 35-9.

87. In regards to **claim 32**, Hirayama in view of Ohno discloses the method according to claim 31, wherein the video management information further includes information on a location of the first font data on the optical disc. Hirayama at col. 11, lines 40-6.

88. In regards to **claim 34**, Hirayama in view of Ohno discloses the apparatus according to claim 16, further comprising a pickup unit to reproduce video management information from the optical disc (Hirayama at col. 11, lines 13-6), the video management information including information indicating whether or not the first font data are recorded on the optical disc.

Hirayama at col. 8, lines 35-9.

89. In regards to **claim 35**, Hirayama in view of Ohno discloses the apparatus according to claim 34, wherein the video management information further includes information on a location of the first font data on the optical disc. Hirayama at col. 11, lines 40-6.

90. In regards to **claim 40**, Hirayama in view of Ohno discloses the apparatus according to claim 17, wherein said external source comprises an optical disc. Hirayama at col. 5, lines 30-9.

91. In regards to **claim 41**, Hirayama in view of Ohno discloses the apparatus according to claim 16, wherein said specific presentation data is text subtitle for the main title. Hirayama at col. 12, lines 26-48.

92. In regards to **claim 42**, Hirayama in view of Ohno discloses the apparatus according to claim 24, wherein said external source comprises an optical disc. Hirayama at col. 5, lines 30-9.

93. In regards to **claim 43**, Hirayama in view of Ohno discloses the method according to claim 23, wherein said specific presentation data is text subtitle for the main title. Hirayama at col. 12, lines 26-48.

***Response to Amendment***

**Specification**

94. Applicant's amendment to the Specification and abstract is acknowledged. However, the amendments seem to add new matter as addressed above in the rejection under 35 U.S.C. 251 and 112, first paragraph. Consequently, the amendment to the Specification and abstract will not be entered.

**Objection to claim 10 for Minor Informalities**

95. Applicant's amendment to claim 10 to address the minor informalities is acknowledged. Consequently, the objection to claim 10 is withdrawn.

**Rejection of Claims 27 and 28 under 35 U.S.C 112, Second Paragraph**

96. Applicant's amendment to claims 27 and 28 is acknowledged. The rejection to claims 27 and 28 under 35 U.S.C. 112, second paragraph is withdrawn.

***Response to Arguments***

**Rejection of claims 1, 2, 4, 9, 16, 22, 23, 29, and 33-35 under 35 U.S.C. 102(e)**

97. Claim 33 is cancelled rendering the rejection to it moot.

98. Applicant's arguments in regards to the rejections to claims 1, 2, 4, 9, 16, 22, 23, 29, 34, and 35 under 35 U.S.C. 102(e), have been fully considered but they are not persuasive. In regards to independent claims 1, 4, and 9, Applicant alleges that Hirayama fails to disclose



character data that is separate from font data (Remarks at 17-8.) The Examiner respectfully disagrees.

99. As can be seen in figure 5A of Hirayama, there is displayed a table with various languages. Figure 5A shows English and Japanese. These languages cannot possibly be displayed in the same font because font used to display English does not contain the characters needed to display Japanese. Hirayama at col. 8, lines 56-67. Thus, Hirayama discloses character data and font data.

100. In regards to claims 16 and 23, Applicant alleges Hirayama fails to disclose (1) font data and (2) a processor processing the additional contents data including the first font data stored in the first memory of the optical disc player, the first font data being different than a second font data predetermined for the main title, and the first and second font data are different than text data (Remarks at 18.) Claims 16 and 23 are now rejected under 35 U.S.C. 103(a) over Hirayama in view of Ohno. Therefore, the rejection of claims 16, 22, 23, 29, 34, and 35 under 35 U.S.C. 102(e) is withdrawn. However, new grounds of rejection are set forth above as necessitated by Applicant's amendment.

101. As discussed above, Hirayama discloses font data. In regards to the second feature, Ohno discloses a font ROM storing character patterns that are used to generate characters for display on the screen with video images stored on a laser disc (i.e., optical disc). Ohno at Fig. 4, element 2; col. 3, lines 54-60; col. 4, lines 1-17. Both Hirayama and Ohno are directed toward character and font processing on an optical disc. Thus, adding the font ROM of Ohno to Hirayama would have been obvious to one of ordinary skill in the art at the time of the invention because the font ROM would save storage space on the optical disc for non-font related data.

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102. Thus, the combination of Hirayama and Ohno discloses features (1) and (2) as discussed above.

103. Consequently, the rejection to claims 1, 2, 4, and 9 under 35 U.S.C. 102(e) is maintained. Claims 16, 22, 23, 29, 34, and 35 are now rejected under 35 U.S.C. 103(a) as set forth above.

**Rejection of claims 3, 5-8, 10, 11, 20, 21, 27, and 28 under 35 U.S.C. 103(a)**

104. Claims 20 and 27 are cancelled rendering the rejection to them moot.

105. Applicant's arguments in regards to the rejections to claims 3, 5-8, 10, 11, 21, and 28 under 35 U.S.C. 103(a), have been fully considered but they are not persuasive. Applicant applies the same arguments as presented in regards to claims 1, 4, and 9, which have been addressed above. Consequently, the rejection to claims 3, 5-8, 10, 11, 21, and 28 under 35 U.S.C. 103(a) is maintained.

**Rejection of claims 17, 19, 24, 26, and 30-32 under 35 U.S.C. 103(a)**

106. Applicant's arguments in regards to the rejections to claims 17, 19, 24, 26, and 30-32 under 35 U.S.C. 103(a), have been fully considered but they are not persuasive. Applicant applies the same arguments as presented in regards to claims 1, 4, and 9, which have been addressed above. Consequently, the rejection to claims 17, 19, 24, 26, and 30-32 under 35 U.S.C. 103(a) is maintained.

***Conclusion***

107. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

108. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

109. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Le whose telephone number is 571-272-7970. The examiner can normally be reached on Mon-Thurs : 9:30am-6pm, Fri: 8am-4:30pm.

110. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

111. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael Le/  
Examiner, Art Unit 2163

/Hung T Vy/

Primary Examiner, Art Unit 2163/Hung T Vy/

Primary Examiner, Art Unit 2163